



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/722,834

11/26/2003

Dar-Shyang Lee

15358-008700

8170

20350

7590

11/13/2008

TOWNSEND AND TOWNSEND AND CREW, LLP

TWO EMBARCADERO CENTER

EIGHTH FLOOR

SAN FRANCISCO, CA 94111-3834

EXAMINER

TAYLOR, NICHOLAS R

ART UNIT

PAPER NUMBER

2441

MAIL DATE

DELIVERY MODE

11/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/722,834

Applicant(s)

LEE ET AL.

Examiner

Nicholas Taylor

Art Unit

2441

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. Claims 1-52 have been presented for examination and are rejected.

Response to Arguments

2. Applicant's arguments filed August 11th, 2008, have been fully considered but they are deemed not persuasive.
3. In the remarks, applicant argued in substance that:

(A) The prior art of Hind does not teach note-taking or a note-taking device. Instead, Hind merely teaches a portal page rendering system that provides partially-complete portal pages when some portlet content is not ready at the time of the request.

As to point (A), Applicant has argued that portal pages cannot function as a note-taking medium while not pointing out the particular aspects of the portal medium that preclude note-taking functionality. Hind describes a "content framework" that includes portal pages (paragraph 0010). Portal pages may be designed "using a notebook paradigm" that includes user-generated content, applications, and other interactive modifications made by the user (see paragraphs 0005 and 0006). The user can take notes that include, e.g., calendar entries and scheduling charts, and the user may

include information which is captured by one or more capture devices (see paragraph 0031 and figs. 3A and 3B).

(B) The prior art of Hind does not teach storing the first request in the notes document. The refresh response header in Hind is not the request, but is instead a response to a portal page request. Additionally, the prior art of Hind does not teach determining whether information is accessible to the note-taking device, as Hind is concerned with determining whether information is accessible to the server.

As to point (B), Hind teaches determining if the portion of the first information requested by the first request is accessible to the device (Hind, see paragraphs 0031-0033 and figs. 2A-2C, 3A, and 3B) and storing the first request in the notes document upon determining that the portion of the first information requested by the first request is not accessible to the device (Hind, paragraphs 0031-0033 where the request is stored in the document if the portion of the first information is not available; see also visual representation in fig. 3A). Applicant appears to characterize the request in Hind as a response because information transfers (e.g., header information) may occur during the request. However, no limiting language is present in the independent claim that more precisely defines the boundaries of what constitutes a "request." As such, the claim language is given its broadest reasonable interpretation. As to the argument that Hind determines only what is accessible to the server and not to note-taking device, the Examiner respectfully asserts, without conceding to the presented interpretation of Hind,

that whatever is not available to the portal server is accordingly inaccessible to the note-taking device.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-11, 15-28, 32-45, and 49-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Hind et al. (U.S. PGPub 2004/0205555).

6. As per claims 1, 18, 35, and 52, Hind teaches a method of taking notes in a notes document using a note-taking device (Hind, paragraphs 0026 and 0027 overview and summary, where the portal page is a functional equivalent in an end-user device; see also 0045), the method comprising:

generating a first request at the note-taking device to insert a portion of a first information in a first location in the notes document, the first information comprising information captured by one or more capture devices; (Hind, see, e.g., example information types described in paragraph 0031 and displayed in fig. 3B where a portion of a first information is displayed from a capture device)

determining if the portion of the first information requested by the first request is accessible to the note-taking device; and (Hind, see paragraphs 0031-0033 and figs. 2A-2C, 3A, and 3B)

storing the first request in the notes document upon determining that the portion of the first information requested by the first request is not accessible to the note-taking device (Hind, paragraphs 0031-0033 where the request is stored in the document if the portion of the first information is not available; see also visual representation in fig. 3A).

7. As per claims 2, 19, and 36, Hind teaches the system further wherein the determining comprises determining if the note-taking device can communicate with the server storing the portion of the first information (Hind, see paragraphs 0031-0033 and figs. 2A-2C, 3A, 3B, and process of fig. 5, 6A, and 6B).

8. As per claims 3, 20, and 37, Hind teaches the system further comprising:
determining, subsequent to storing the first request in the notes document, if the note-taking device can communicate with a server (Hind, see paragraphs 0031-0033 where subsequent determinations are made).

9. As per claims 4, 21, and 38, Hind teaches the system further wherein determining if the note-taking device can communicate with the server comprises:
detecting a first signal after storing the first request in the notes document; and determining if the note-taking device can communicate with the server responsive to the

first signal (Hind, see paragraphs 0031-0033 and figs. 2A-2C, 3A, 3B, and process of fig. 5, 6A, and 6B).

10. As per claims 5, 22, and 39, Hind teaches the system further wherein the first signal is generated when the notes document is opened (Hind, see paragraphs 0031-0033 and figs. 2A-2C, 3A, 3B, and process of fig. 5, 6A, and 6B).

11. As per claims 6, 23, and 40, Hind teaches the system further wherein the first signal is generated at a periodic interval (Hind, see, e.g., the periodic request method outlined in paragraph 0028).

12. As per claims 7, 24, and 41, Hind teaches the system further wherein the first signal is generated in response to an action performed by a user of the note-taking device (Hind, see paragraphs 0031-0033 and figs. 2A-2C, 3A, 3B, and process of fig. 5, 6A, and 6B).

13. As per claims 8, 25, and 42, Hind teaches the system further comprising:
communicating the first request from the note-taking device to the server;
receiving, at the note-taking device, the first portion of the first information from the server; and (Hind, see paragraphs 0031-0033 and figs. 2A-2C, 3A, 3B, and process of fig. 5, 6A, and 6B)

embedding the first portion of the first information in the first location in the notes document (Hind, e.g., see fig. 3 embedding information in the document).

14. As per claims 9, 26, and 43, Hind teaches the system further comprising:

communicating, from the note-taking device to the server, information identifying a user of the note-taking device requesting the first portion of the first information; determining, at the server, if the user is authorized to receive the first portion of the first information; and communicating the first portion of the first information from the server to the note-taking device if it is determined that the user is authorized to receive the first portion of the first information (Hind, see paragraphs 0039 and fig. 4 authorized user access).

15. As per claims 10, 27, and 44, Hind teaches the system further comprising:

communicating, from the note-taking device to the server, information identifying a user of the note-taking device requesting the first portion of the first information; and determining, at the server, if the user is authorized to receive the first portion of the first information (Hind, see paragraphs 0039 and fig. 4 user access).

16. As per claims 11, 28, and 45, Hind teaches the system further comprising:

determining one or more requests stored in the notes document, the one or more requests including the first request; communicating the first request from the note-taking device to the server; receiving, at the note-taking device from the server, the first portion

of the first information; and (Hind, see paragraphs 0031-0033 and figs. 2A-2C, 3A, 3B, and process of fig. 5, 6A, and 6B)

embedding the first portion of the first information in the first location in the notes document (Hind, e.g., see fig. 3 embedding information in the document).

17. As per claims 15, 32, and 49, Hind teaches the system further wherein storing the first request in the notes document comprises: inserting a visual marker in the first location in the notes document indicative of the first request (Hind, see fig. 3A and paragraph 0032).

18. As per claims 16, 33, and 50, Hind teaches the system further wherein the first information comprises information captured during a first presentation, the method further comprising:

generating, at the note-taking device during the first presentation, a second request to insert a portion of a second information in a second location in the notes document, the second information comprising information captured during a second presentation; determining if the portion of the second information requested by the second request is accessible to the note-taking device; and (Hind, see paragraphs 0031-0033 and figs. 2A-2C, 3A, 3B, and process of fig. 5, 6A, and 6B; see repetition, e.g., of paragraph 0033)

storing the second request in the notes document upon determining that the portion of the second information requested by the second request is not accessible to

the note-taking device (Hind, paragraphs 0031-0033 where the request is stored in the document if the portion is not available; see also visual representation in fig. 3A; see repetition, e.g., of paragraph 0033).

19. As per claims 17, 34, and 51, Hind teaches the system further comprising:

identifying one or more requests stored in the notes document, the one or more requests including the first request and the second request; communicating the first request and the second request from the note-taking device to a server; (Hind, see paragraphs 0031-0033 and figs. 2A-2C, 3A, 3B, and process of fig. 5, 6A, and 6B; see repetition, e.g., of paragraph 0033)

receiving, at the note-taking device from the server, the portion of the first information and the portion of the second information; embedding the portion of the first information in the first location in the notes document; and embedding the portion of the second information in the second location in the notes document (Hind, paragraphs 0031-0033 where the request is stored in the document if the portion is not available; see also visual representation in fig. 3A; see repetition, e.g., of paragraph 0033).

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 12-14, 29-31, and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hind et al. (U.S. PGPub 2004/0205555) and Chiu et al. (U.S. Patent 6,452,615).

22. As per claims 12, 29, and 46, Hind teaches the above, yet fails to teach wherein the first information comprises information captured during a first presentation and wherein the portion of the first information is a slide displayed during the first presentation.

Chiu teaches a method of creating information comprising captures from presentation for insertion in a note document (Chiu, abstract and col. 3, lines 22-57). The information includes slides, audio segments, video segments, and images displayed during the presentation (Chiu, col. 4, lines 47-60; col. 5, lines 8-20; col. 3, lines 22-57; see figs. 3 and 7).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Hind and Chiu to provide the presentation capture of Chiu in the system of Hind, because doing so would enable notes document capabilities to extend to a broader range of information including the effective capture of demonstrations during presentations and training sessions (Chiu, col. 3, lines 31-63; see also similar presentation style data of Hind fig. 3B element 350; where both systems are further directed to TCP/IP network-based access of centralized user-relevant information).

23. As per claims 13, 30, and 47, Hind teaches the above, yet fails to teach wherein the first information comprises information captured during a first presentation and wherein the portion of the first information is at least one of an audio segment recorded during the first presentation and a video segment recorded during the first presentation.

Chiu teaches a method of creating information comprising captures from presentation for insertion in a note document (Chiu, abstract and col. 3, lines 22-57). The information includes slides, audio segments, video segments, and images displayed during the presentation (Chiu, col. 4, lines 47-60; col. 5, lines 8-20; col. 3, lines 22-57; see figs. 3 and 7).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Hind and Chiu to provide the presentation capture of Chiu in the system of Hind, because doing so would enable notes document capabilities to extend to a broader range of information including the effective capture of demonstrations during presentations and training sessions (Chiu, col. 3, lines 31-63; see also similar presentation style data of Hind fig. 3B element 350; where both systems are further directed to TCP/IP network-based access of centralized user-relevant information).

24. As per claims 14, 31, and 48, Hind teaches the above, yet fails to teach wherein the first information comprises information captured during a first presentation and wherein the portion of the first information is at least one of an image displayed during the first presentation, and text information recorded during the first presentation.

Chiu teaches a method of creating information comprising captures from presentation for insertion in a note document (Chiu, abstract and col. 3, lines 22-57). The information includes slides, audio segments, video segments, and images displayed during the presentation (Chiu, col. 4, lines 47-60; col. 5, lines 8-20; col. 3, lines 22-57; see figs. 3 and 7).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Hind and Chiu to provide the presentation capture of Chiu in the system of Hind, because doing so would enable notes document capabilities to extend to a broader range of information including the effective capture of demonstrations during presentations and training sessions (Chiu, col. 3, lines 31-63; see also similar presentation style data of Hind fig. 3B element 350; where both systems are further directed to TCP/IP network-based access of centralized user-relevant information).

Conclusion

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Taylor whose telephone number is (571) 272-3889. The examiner can normally be reached on Monday-Friday, 8:00am to 5:30pm, with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/NT/
Nicholas Taylor
Examiner
Art Unit 2441

/Jason D Cardone/
Supervisory Patent Examiner, Art Unit 2445